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Proceeding	85864287
Applicant	Shanon Preston
Applied for Mark	UNRATED
Correspondence Address	ANDREW LAHSER LAW OFFICE OF ANDREW P LAHSER PLC 16824 E AVENUE OF THE FOUNTAINS, SUITE 14 FOUNTAIN HILLS, AZ 85268-8408 UNITED STATES docket@lahserpatent.com
Submission	Appeal Brief
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Filer's Name	Andrew P Lahser
Filer's e-mail	docket@lahserpatent.com
Signature	/Andrew P Lahser/
Date	09/15/2014

Law Office of Andrew P. Lahser, PLC
16824 E. Avenue of the Fountains, Suite 14
Fountain Hills, AZ 85268
Telephone: (480) 816-9383
Facsimile: (480) 837-5378

Andrew P. Lahser, Esq.
Attorney for Applicant/Appellant

In The United States Patent And Trademark Office
Before the Trademark Trial and Appeal Board

Mark: **UNRATED**

Applicant: **Shanon Preston**

Serial No.: **85/864,287**

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Examining Attorney: **Wendell S. Phillips III**

Law Office No.: **110**

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Applicant's Brief

Applicant hereby appeals the Examining Attorney's final refusal to register Applicant's mark, UNRATED for apparel.

The Examining Attorney's final refusal was based on the Examining Attorney's belief that Applicant's Mark is likely to be confused with the mark UNRSTED shown in US Registration No. 3,332,414. Applicant believes and has shown the following facts in support of registration to overcome, respectfully, the Examiners refusal:

1. a number of similar marks are presently in use on related or identical goods;
2. the goods, while normally related, travel in different trade channels and Applicant has amended its *goods and services description* to indicate its precise channel of trade; and

3. in light of the distinct channels of trade, the commercial impressions differ enough to avoid a likelihood of confusion because consumers would encounter each mark pursuant to a distinct consuming experience.

Brief Recitation of the Facts and Evidence

Applicant originally applied for the mark UNRATED based on intent to use. Applicant has been using this mark in commerce since at least April 2013, but, is delaying filing a Statement of Use pending the outcome of this appeal.

The Examiner's original refusal for a likelihood of confusion also included the mark NOT RATED for footwear and having the Reg. No. 3,332,414. After Applicant's response to the original office action, Examiner withdrew this mark as a basis for refusal.

Applicant submitted the registration certificates for all of the following marks. The Goods descriptions are paraphrased for convenience.

Reg. No.	Mark	Goods
797,265	PRO-RATED	men's & boy's outer garments
1,701,132	TEAM RATED	t-shirts, sweatshirts and pants
2,056,365	TR TEAM RATED (stylized)	tops and bottoms
2,163,868	RATED X MAS	tee shirts, jackets, hats, shorts, sweatshirts, and underclothes
2,996,623	RATED X	clothing and footwear
3,322,308	G-RATED CLOTHING	t-shirts, hats, sweatshirts, shoes and pants
3,694,848	FIVE STARS RATED	hats and shirts
3,774,459	RATED	clothing and apparel
3,817,572	UNDER RATED	men's, woman's and children's clothing
4,359,360	RATED M BY MARIO LOPEZ	underwear, shirts, loungewear, and shorts
3,332,414	NOT RATED	footwear

Trademarks that incorporate the term "rated" to call to mind the movie rating system are quiet popular. Above, these trademarks show that there are a good number of live marks that contain "*rated*", all for highly, similar goods related to apparel. Applicant submits this as evidence that the consumer may already be distinguishing among a plurality of marks that have similarity of appearance, similarity of goods, but distinct meanings.

In particular, most of these marks are akin to one of the Motion Picture Association of America's film rating system. Commonly motion pictures in the USA are rated by **G** — General Audience, **PG** — Parental Guidance, **PG-13**, Parents Strongly Cautioned, **R** — Restricted, and **NC-17** — No One under 17 admitted. The above marks show that just a small change of letters can significantly change the meaning of the mark, in part, because of the mental association with this film rating system.

Additionally, the term “**NR** — Not Rated” is sometimes used to indicate that a film is not rated, but, it is not part of the film rating system.

More specifically, a good number of these marks quiet clearly call to mind a related MPAA movie rating. For example, the following marks are capable of calling to mind the MPAA's system or a specific rating, as follows:

Reg. No.	Mark	Calls to mind
2,163,868	RATED X MAS	MPAA's NC-17 rating
2,996,623	RATED X	MPAA's NC-17 rating
3,322,308	G-RATED CLOTHING	MPAA's G rating
3,774,459	RATED	MPAA's rating system, generally
3,817,572	UNDER RATED	MPAA's rating system, generally
4,359,360	RATED M BY MARIO LOPEZ	MPAA's NC-17 rating
3,332,414	NOT RATED	MPAA's rating system, generally

So, it is not only the number of third-party marks, but, how those third party marks are creating their commercial impressions with consumers that is relevant in any likelihood of confusion analysis.

Which DuPont Factors are relevant to a determination of a likelihood of confusion?

It is well established that the following DuPont factors are relevant in any likelihood of confusion analysis during examination of a trademark application. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

- The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in the application and registration,

In addition, the following two factors are also relevant to the analysis in this case.

- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The number and nature of similar marks in use on similar goods.

See, e.g., du Pont, 476 F.2d at 1362-63, 177 USPQ at 568-69.

Statement of the Issue

*While generally the Board finds footwear and apparel related, under what circumstances have courts specifically found that different items of apparel or footwear are sufficiently unrelated to support a finding of **no likelihood of confusion when used on similar marks?***

At one time, the Board seemed to have a *per se* rule that the use of the same or a similar mark on different items of apparel was likely to cause confusion; yet, more recent decisions re-emphasize that each case is to be determined on its own particular facts and circumstances. *See In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984).

In the case of *In re British Bulldog, Ltd.*, the Board held that the mark PLAYERS on men's underwear and shoes would not result in consumer confusion as to the source of the goods. Here, the connotation of the term was deemed to be different as applied to the respective goods. The board said that "PLAYERS' for shoes implies a fit, style, color and durability adapted to outdoor activities. 'PLAYERS' for men's underwear implies something else, primarily indoors in nature."

In this case, the two marks project slightly different connotations because of the highly unusual spelling of Registrant's mark. As previously explained, Applicant's mark calls to mind the movie rating system. Registrant's mark is unlikely to do so. As anyone who has abbreviated words in SMS messages knows or otherwise written in 1337 (leet) speak, you would not abbreviate proper names, such as trademarks. So, in order for Registrant's mark to call to mind the movie rating system, two steps would be required. First, the consumer would have to "translate" from SMS abbreviations to english; second, the consumer would have to connect the meaning of this word to a trademark term, which is contrary to the custom.

Also, Applicant has specified that it sells only through its online stores. As such, any consumer who purchases from Applicant would necessarily be faced directly with the visual differences between the two trademarks, because, online stores are presented visually to users on computing device screens. Said another way,

the visual differences between the marks would be apparent to every consumer that encounter's Applicant's store, because, they must see Applicant's mark visually on Applicant's online store presented on their computer screen; which is the only channel of trade specified by the Applicant's goods description.

In the case of *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 202 USPQ 81 (2nd Cir. 1979), the 2nd Circuit found no likelihood of confusion between senior users' DRIZZLER for men's golf jackets and junior user's DRIZZLE for women's overcoats and raincoats. These marks are highly similar, and, the goods are nearly identical — jackets and coats. One factor, which weighed heavily in the junior user's favor, was the *competitive distance* between the marks, citing the District court:

The impression that noncompeting goods are from the same origin may be conveyed by such differing considerations as the physical attributes or essential characteristics of the goods, with specific reference to their form, composition, texture or quality, the service or function for which they are intended, ***the manner in which they are advertised, displayed or sold, the place where they are sold***, or the class of customers for whom they are designed and to whom they are sold. *Drizzle*, 599 F.2d at 1135. (emphasis added)

In this case, Applicant has specified that it markets its products directly to consumers solely through its own online stores. Similar to *McGregor-Doniger Inc. v. Drizzle*, the Board should consider this specific manner in which Applicant advertises, displays and sells its apparel. That is, Applicant's stores only include Applicant's products, to the exclusion of all others. So, consumers would never encounter Applicant's goods in the same context as Registrant's goods, thereby lessening any potential likelihood of confusion. It is easy to see that this could be similar to the sale of golf jackets, which would likely occur in different locations, like pro golf shops on golf courses, rather than woman's fashionable overcoats, which may occur in customary fashion channels. *See also A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 57 USP 1097 (3d Cir. 2000) (no likelihood of confusion between senior MIRACLESUIT for swimwear versus junior MIRACLE BRA on swimwear).

In the case of *H. Lubovsky, Inc. v. Esprit De Corp.*, 627 F.Supp. 483, 228 USPQ 814 (SDNY 1986), the court found that the senior user's trademark ESPRIT for footwear was strong enough to create a likelihood of confusion with respect to the junior user's use on shoes, but, did not create a likelihood of confusion with respect to the junior user's use on apparel. The court stated that while there was generally a relationship between footwear and apparel,

...there is also an appreciable distance between plaintiff's shoes and defendant's clothing which diminishes the likelihood of confusion. *Shoes are generally sold in shoe stores or shoe departments of department stores.* Most frequently, therefore, they are either in a different store, or a different department, from sportswear. 627 F.Supp at 488.

So, the court considered that the shoes are generally sold *in separate stores or departments* than other apparel was a factor in finding no likelihood of confusion. Similarly, Applicant has limited its use to only its own online stores. It is less likely that shoes will be sold online, due to fit issues, than other forms of apparel, where fit may be comfortably less precise. So, the online nature of Applicant's stores further reduces the likelihood of confusion. *See also Clark & Freeman Corp. v. Heartland Co. Ltd.*, 811 F.Supp. 137, 25 USPQ2d 2030 (SDNY 1993) (senior user of the mark HEARTLAND for boots could not expand its use to shirts because of the junior user's mark HEARTLAND for clothing, because there had been no likelihood of confusion).

In the case of *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (2006), the senior users mark TUNDRA for clothing was not likely to be confused with the junior users mark TUNDRA on shirt that were sold in automotive dealerships.

Opposer [senior user] argues that the goods are "inherently" related, contending that automobile manufacturers often use the same trademarks on automobiles and clothing; that it is common for automobile manufacturers to sell both automobiles and clothing and that clothing manufacturers use marks used for their clothing in connection with the sale of automobiles; of the automobile industry, including Toyota [junior user], to use the same trademarks on both automobiles and clothing. 77 USPQ2d at 1933.

The court then goes on to state that the senior user's clothing is sold through customary channels for goods, such as apparel shops and department stores. The junior user's goods were sold through automobile dealerships, which are essentially stores under the control of the junior user, that sell primarily the goods of the junior user, and certainly not goods of the kind offered by the senior user.

In this case, Applicant has similarly specified that its goods are available only directly through its own online store, which does not sell shoes (because those are not listed in Applicant's registration), and which does not sell goods of others. *See also, In Re the Shoe Works Inc.*, 6 U.S.P.Q.2d 1890 (TTAB 1988) (no likelihood of confusion between senior user of the mark PALMBAY for shorts

and pants shoes and junior user's mark PALM BAY on shoes where the shoes were limited to sales solely through junior user's own stores.)

Conclusion

The Applicant hereby respectfully requests that the Board carefully consider the facts, arguments and amendment presented herein and reverse the Examiner's refusal to register Applicant's mark. Applicant believes that its UNRATED mark when used in connection with apparel and sold directly through Applicant's online store, will not be likely to be confused with Registrant's mark UNRSTED when used on footwear in separate channels of trade, because:

1. many other third-party, similar marks call to mind the MPAA rating system, which Applicant calls to mind, and Registrant does not;
2. the goods travel in distinct, non-overlapping channels of trade; because Applicant's goods are only sold in Applicant's online stores, and not elsewhere; and
3. given the differences in channels of trade and the visual circumstance inherent in online sales, the marks make sufficiently different commercial and visual impressions to avoid confusion.

For all the above reasons, the Applicant respectfully requests that the Examiner allow Applicant's application for the mark, UNRATED, to register.

Yours truly,

Law Office of Andrew P. Lahser, PLC

/Andrew P. Lahser/

Andrew P. Lahser

Attorney for Applicant

16824 E. Ave. of the Fountains, Suite 14

Fountain Hills, AZ 85268

(480) 816-9383

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